



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/444,968 11/22/99 VANDEVOORDE

F AC02587P1US

EXAMINER

IM22/0306

JOAN M. MCGILLYCUDDY
AKZO NOBEL INC
INTELLECTUAL PROPERTY DEPARTMENT
7 LIVINGSTONE AVENUE
DOBBS FERRY NY 10522-3408

BAGWELL, M

ART UNIT

PAPER NUMBER

1711

DATE MAILED:

03/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/444,968

Applicant(s)

VANDEVOORDE ET AL.

Examiner

Melanie D. Bagwell

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1-19-01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 and 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 12 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-6 and 12, in Paper No. 7 is acknowledged. The traversal is on the ground(s) that it would not be a burden to the examiner to prosecute Groups I and II together. This is not found persuasive because, as evidenced in Paper No. 6 by the difference in classification, the two inventions would require two separate search strategies.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2, 4-5, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ho.

4. Ho discloses a composition to be used as a clearcoat (col. 24 lines 26-28) comprising 2-butyl-2-ethyl-1,3-propanediol, an isocyanate, and two polyol compounds (see Table 5). Polyol IV of the composition in example 8 is a carbinol-terminated siloxane having an OH equivalent of 98, and Polyol I of the example is a polyester diol with an OH equivalent of 72.9 (see Table 1). The propanediol compound fits the

Art Unit: 1711

applicant's formula of claim 1, where R is n-butyl. Based on the weight of the combined polyols, the propanediol compound comprises ~15% by weight of the composition. The composition also comprises methyl ethyl ketone, a volatile organic solvent. Thus, the combination present in example 8 for use in a coating composition anticipates the applicant's claimed coating composition.

5. The present rejection based on 35 USC 102 hereby replaces the rejection of claims 1-2, 4-5, and 12 based on 35 USC 103 from a prior Office action. Upon reconsideration of the claims, it is the examiner's position that the cited reference reads on the broadest interpretation of the claims. Claim 1 is drawn to a coating composition comprising three specified components. The reference teaches these components as part of a prepolymer of use in the coating composition. Therefore, the coating composition of Ho's invention contains the three components. The applicant's arguments to the rejections of claims 1-2, 4-5, and 12 based on 35 USC 103 have not been addressed because it is the examiner's position that they are not pertinent to the current rejections based on 35 USC 102.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. The rejection of claims 3 and 6 based on 35 USC 103 over Ho has been maintained. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho.

8. Ho applies as above, failing to exemplify the use of an acrylate polymer with the composition of the invention. The example presented by Ho does not teach the use of an acrylic polymer; however, Ho notes the possible addition of a polyacrylate polyol to the coating composition to improve gloss retention and decrease drying time of the coating (col. 16 lines 18-34). Therefore, it would have been prima facie obvious to include an acrylate polyol in the exemplified coating composition to improve gloss retention of the coating.

9. Regarding the applicant's arguments that the addition of the acrylate would not have been obvious based on motivation, it is noted that Ho teaches acrylic polymers having hydroxyl functionality to be added to the composition of the invention (col. 16 lines 18-34). Motivation for incorporating the acrylic polymer, as stated above and in a prior Office action, would have been to improve gloss retention of the cured coating.

Allowable Subject Matter

10. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

12. The reference teaches a coating composition comprising two hydroxy-group containing polymers, a polyisocyanate, and a diol fitting the applicant's formula of claim

1. Although polyester and polyurethane polyols are taught as possible hydroxy-group

Art Unit: 1711

containing polymers or additives, the reference does not teach the polymers derived from the specified diol combined with the composition. It is the examiner's position that the polymer derived from the diol, when added to the composition of the diol, isocyanate, and polyol, is novel and unobvious over the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bagwell whose telephone number is (703)308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703)308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)872-9309.

mdb
February 28, 2001


RACHEL GORR
PRIMARY EXAMINER